

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 6

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-11 and 14-17 are now present in this application. Claims 1, 7, 14 and 15 are independent. By this Amendment, claims 14-17 are added. No new matter is involved.

Reconsideration of this application is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 4, 5, 7, 8, 9 and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,879,555 to Takeuchi. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

EHĆ/RJW/jmc

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 7

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the Applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

Moreover, as stated in M.P.E.P. § 707.07(d), where a claim is refused for any reason relating to the merits thereof, it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference. *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claims 1 and 7 recite a combination of features that is not disclosed by Takeuchi. For example, claim 1 recites detecting a level of a wobble extraction signal while a focusing servo is

EHC/RJW/jmc

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 8

turned on but before a focusing servo adjustment has been completed. Claim 7 includes similar features, but is a means-plus-function claim.

Takeuchi does not disclose these claimed combinations of features. Takeuchi contains absolutely no disclosure of detecting a wobble extraction signal in while a focusing servo is turned on but before a focusing servo adjustment has been complete, as recited.

The Office Action asserts that the step of detecting a wobble extraction signal is disclosed in steps S601, S603 and S603. However, there is no mention whatsoever in Takeuchi of a wobble extraction signal, let alone of detecting a wobble extraction signal, nor of detecting a wobble extraction signal while a servo is turned on but before a focusing servo adjustment is made, as claimed. Thus, the Office Action fails to provide a showing that there is an explicit disclosure of this aspect of the claimed invention by Takeuchi.

Furthermore, the Office Action does not provide a showing that Takeuchi inherently discloses detecting a wobble extraction signal while a servo is turned on but before a focusing servo adjustment is made, as claimed. In this regard, as noted above, for something to be inherently disclosed, it must be not just possibly disclosed, and not just probably disclosed, but it must necessarily be disclosed.

The Office Action does not provide any evidence whatsoever to show that Takeuchi's steps S601, S602 and S603 necessarily disclose detecting a wobble extraction signal while a servo is turned on but before a focusing servo adjustment is made, as claimed.

Further, with respect to claim 2, the Office Action concludes that the level of wobble extraction signal is detected while the tracking servo is turned off. As shown above, Takeuchi

EHC/RJW/jmc

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 9

does not disclose, either explicitly or inherently, detecting the level of a wobble extraction signal. Additionally, just because Takeuchi discloses that an automatic adjusting operation with respect to a focus servo and a tracking servo and laser power (col. 8, lines 59-64) does not necessarily mean that the tracking servo was turned off. Takeuchi never discusses when it turns on its tracking servo, which may well occur when the device is turned on.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of claims 1, 2, 4, 5, 7, 8, 9 and 10 by Takeuchi.

Reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 3, 6 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the

EHC/RJW/jmc

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 10

invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir.

EHC/RJW/jmc

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 11

1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

Claims 3 and 6 depend from claim 1, which patentable defines over Takeuchi for reasons discussed above. Claim 11 depends from claim 7, which patentable defines over Takeuchi for

EHC/RJW/jmc

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 12

reasons discussed above.

So, even if one of ordinary skill in the art were properly motivated to modify Takeuchi, as suggested, the resulting modified version of Takeuchi would still not disclose, suggest, or otherwise render obvious, the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 3, 6 and 11.

Reconsideration and withdrawal of this rejection of claims 3, 6 and 11 are respectfully requested.

New Claims

New claims 14-17 are added. Claims 14 and 15 depend from either claim 1 or claim 7 and patentably define over Takeuchi at least for the reasons presented above regarding the patentability of claims 1 and 7 with respect to Takeuchi, and for the specific features recites on these dependent claims. Claims 16 and 17 were previously presented as claims 12 and 13, which were canceled by Examiner's Amendment.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response

EHC/RJW/jme

Application No.: 10/769,813
Art Unit 2627

Attorney Docket No. 1630-0455PUS1
Reply to Office Action dated May 9, 2008
Page 13

has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

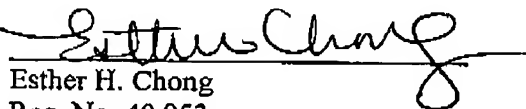
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: August 7, 2008

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:



Esther H. Chong
Reg. No. 40,953
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000

EHC/RJW/jmc